

## REMARKS

The Applicant has reviewed and fully considered the May 13, 2008 Office Action received in the above-referenced application.

Claim 4 is objected to as being dependent upon a rejected base claim. The Applicant has amended Claim 4 as suggested to incorporate all of the limitations of Claims 1 and 3. The Applicant respectfully requests this objection be withdrawn

Claim 1-3, 6 and 7 are rejected under 35 USC 103(a) as being unpatentable over Montgomery *et al* (US Patent No. 2,923,192). Reconsideration of these rejections is requested. In rejecting Claim 1 the Examiner stated “It is noted that it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art.” May 13, 2008 Office Action Page 2. The Examiner goes on to explain how the limitation of having the group of clamping devices removable from the drive ring can be obtained by modifying “the invention of Montgomery *et al* (e.g., by forming the lower plate of the housing 2 detachably attached. . .)”. However this would only provide easy removal of the drive wheel with the hydraulic cylinders used for gripping still permanently mounted in the drive wheel. This is not the same as the limitation of the group of clamping devices removable from the drive ring found in Claim 1. Further this reengineering of the prior art is done without any supporting references suggesting it other than to say it would be obvious to one having skill in the art.

From the Applicant’s point-of-view, the Examiner has misapplied the teaching, suggestion, and motivation (TSM) test as explained by *KSR Intl. v. Teleflex*, 550 U.S. \_\_\_, 82 USPQ2d 1385 (2007). Under the TSM test, a patent claim is “only proved obvious if some motivation or

suggestion to combine the prior art teachings can be found in the prior art, the nature of the problem, or the knowledge of a person having ordinary skill in the art.” *Id.* at 1391 (internal quotation omitted) (citation omitted). “[A] patent composed of several elements is not proved obvious merely by demonstrating that each of the elements was, independently, known in the art. . . . [Rather], it can be *important to identify a reason* that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.” *Id.* at 1396 (emphasis added).

In supporting this obviousness rejection, the Examiner relies exclusively on the knowledge of a person having ordinary skill to cite the limitation of the group of clamping devices being removable from the drive ring. In addition to the modified example failing to disclose the claim limitation, the Examiner’s obviousness rejection also departs from the Court’s holdings in *KSR*.

In *KSR*, it was well-known in the art that a sensor could be located on a mechanical pedal, and that the advantages and disadvantages of doing so depended in part on the location of the sensor on the pedal. *See KSR*, 82 USPQ2d at 1392. This knowledge, however, was not enough to support a finding of obviousness. Instead, an actual motivation to combine was required in the context of the applicant’s claimed subject matter. The Court found this motivation in “a marketplace that created a strong incentive to convert mechanical pedals to electronic pedals, and the prior art taught a number of methods for this advance.” *Id.* at 1398. While the Examiner has attempted to point to knowledge in the art and a possible motivation to combine, the Examiner has failed to point out an actual motivation to combine in the specific context of the Applicant’s claimed subject matter. Further the knowledge in the art did not disclose the equivalent of the limitation found in the claim. *KSR* stands

for the proposition that what a person of ordinary skill might know is not enough to support a finding of a teaching, suggestion, or motivation to combine.

KSR also stands for the proposition that a court or an examiner cannot use the Applicant's claims as a blueprint from which to find this motivation or "apparent reason to combine the known elements in the fashion claimed." *Id.* at 1396. "A fact finder should be aware . . . of the distortion caused by hindsight bias and must be cautious of arguments reliant upon ex post reasoning." *Id.* at 1397. The Examiner uses the Applicant's claims as a blueprint in applying the knowledge of someone skilled in the art along with a piece of prior art circa 1960. *KSR*, in contrast, essentially dealt with two patents, Asano and Smith, each of which were closely related to the patent at issue and were filed within ten years of the patent at issue. *See id.* at 1392, 1398. Additionally, all the prior art cited in *KSR* was closely related to the patent at issue and filed within a ten-year time window, 1989–1999. *Id.* While "[t]he mere age of the references is not persuasive of the [non-]obviousness of the combination of their teachings," *In re Wright*, 569 F.2d 1124, 1127, 193 USPQ 332, 335 (CCPA 1977), it is highly suggestive of non-obviousness. If, as the Examiner claims, the motivation to combine resided in the knowledge of one of ordinary skill, then no one of ordinary skill felt it much, if at all, until the Applicant came along and provided it in the form of his claims. By superimposing the Applicant's claimed subject matter on the person of ordinary skill, the Examiner has transformed that person into one of inventive skill.

"We build and create by bringing to the tangible and palpable reality around us new works based on instinct, simple logic, ordinary inferences, extraordinary ideas, and sometimes even genius. These advances, once part of our shared knowledge, define a new threshold from innovation starts once more." *KSR*, 82 USPQ2d at 1400. The inventive step often lies in the combination of things

old. *See id.* at 1396 (noting that most inventions “rely upon building blocks long since uncovered”). If the Applicant’s claimed invention lacks inventiveness—thereby making the Applicant a person of ordinary, and not inventive, skill—then the person of ordinary skill relied upon by the Examiner is apparently less than ordinary. After all, that person of ordinary skill had not yet derived the Applicant’s claims. The logic is tortured. On the one hand, the person of ordinary skill does not invent. On the other hand, the person of ordinary skill is given extraordinary skill in showing an invention obvious by claiming a person of ordinary skill would have done it as the inventor has done it. What the Applicant finds troublesome—that no person of ordinary skill did in fact do it—the Examiner brushes aside with four words, “would have done it.” Would have, could have, and should have are all phrases commonly used in hindsight analysis . . . except when used in the PTO. Here, the words are twisted in a “before the fact” way to discount inventiveness. “Granting patent protection to advances that would occur in the ordinary course without real innovation retards progress,” *id.* at 1396, but so does denying patent protection by conjuring a person of ordinary skill based on the Applicant’s claims.

There is no motivation from the cited prior art reference to provide clamping devices which are removable from the drive ring. This is part of the Applicant’s contribution to the industry. Claims 2, 3, 6 and 7 all depend either directly or indirectly from Claim 1. As such they contain all of the limitations of Claim 1. For the foregoing reasons the Applicant respectfully requests the rejection of Claim 1-3, 6 and 7 under 35 USC 103(a) over Montgomery be withdrawn.

Claim 6 is rejected under 35 USC 103(a) as being unpatentable over Montgomery *et al* in view of Buck (US Patent No. 6,253,643). Claim 6 depends indirectly from Claim 1. As such it contains all of the limitation of Claim 1. As explained above Montgomery does not disclose all of

the limitations of Claim 1. This makes the obviousness rejection of Claim 6 over Montgomery and Buck improper. The Applicant respectfully requests a withdraw of this rejection.

Claims 7-9 are rejected under 35 USC 103(a) as being unpatentable over Montgomery *et al* in view of Lemaire *et al* (US Patent No. 4,567,952). Claims 7-9 all depend either directly or indirectly from Claim 1. As such they contain all of the limitations of Claim 1. As explained above Montgomery does not disclose all of the limitations of Claim 1. This makes the obviousness rejection of Claim 6 over Montgomery and Lemaire improper. The Applicant respectfully requests the rejection of Claim 1-3, 6 and 7 under 35 USC 103(a) over Montgomery be withdrawn.

Claim 10 is rejected under 35 USC 103(a) as being unpatentable over Montgomery *et al* in view of Dyer (US Patent No. 4,321,975). Claim 10 depends indirectly from Claim 1. As such it contains all of the limitations of Claim 1. As explained above Montgomery does not disclose all of the limitations of Claim 1. This makes the obviousness rejection of Claim 10 over Montgomery and Dyer improper. The Applicant respectfully requests a withdraw of this rejection.

The Applicant has amended the claim set to include Claims 11 through 20 for consideration by the Examiner. These new claims provide additional limitations not found in the prior art.

The Applicant believes that he has addressed all the outstanding issues and that the application is in condition for allowance and therefore respectfully requests allowance of the claims. Should any other amendments be necessary to place the application in condition for a Notice of Allowance, Examiner Shakeri is invited to call the undersigned at the below noted telephone number. Further, please debit additional fees required by this paper or credit any overpayment to Deposit Account No. 50-1971.

Respectfully submitted,



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